

REMARKS

I. Status Of The Claims

Claims 1-106 are pending in this application.

Claims 1-106 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (U.S. Application No. 2001/0018739) in view of Ginter (U.S. Patent No. 6,427,140).

Claims 1, 4, 5, 8, 10, 15, 16, 19, 20, 23, 26, and 29 are independent.

II. Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-106 under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Ginter.

With regard to independent claims 1, 5, 16, 20, 23, and 26, the Examiner argues that “Anderson discloses the claimed invention except for the digital rights management container”, and that Ginter discloses a digital rights management container. The Examiner then argues that “it would have been obvious to one having skill in the art at the time the invention was made to utilize a VIDE content container/digital rights management container as taught by Ginter ‘140, since Ginter ‘140 states at Col. 22, lines 15-25 that such a modification would eliminate the constraints of having to use a few high level individual, pre-defined content provider increments” (emphasis added). Although the Examiner indicates “Col. 22, lines 15-25”, it appears that “Col. 22, lines 27-34” was intended.

The portion of Ginter identified by the Examiner discusses “support [for] dynamic user selection of information subsets of a VDE electronic information product” (see col. 22, lines

27-28). Ginter explains that such functionality includes support for “metering and usage control over a variety of increments ... that are selected ad hoc by a user” (see col. 22, lines 34-37), and that “[t]he user may, for example, select certain numbers of bytes of information from various portions of an information product, such as a reference work, and copy them to disc in unencrypted form and be billed based on total number of bytes plus a surcharge on the number of ‘articles’ that provided the bytes” (see col. 23 lines 5-10).

As the Examiner is aware, in order to establish a prima facie case of obviousness, “there must be some suggestion or motivation ... to modify the references or to combine reference teachings” (see MPEP 2142).

Firstly, Applicants believe it clear that mere discussion of a feature (e.g., support for user selection of information subsets) does not constitute a suggestion or motivation to modify references or to combine reference teachings.

Secondly, such support for user selection of information subsets is not relevant to the operations discussed by Anderson.

For at least these reasons, Applicants respectfully submit that the portion of Ginter identified by the Examiner fails to provide the “suggestion or motivation” required to establish a prima facie case of obviousness. Applicants further submit that no other portion of Ginter, nor any other cited reference, provides the required “suggestion or motivation”.

Moreover, for at least the reasons discussed in previous submissions, Applicants disagree with the Examiner’s assertion that Anderson and Ginter disclose, teach, or suggest all aspects of claims 1, 5, 16, 20, 23, and 26.

Applicants recognize the Examiner’s citation of *Ex parte Masham*, 2 USPQ2d 1647, but believe this case law to be inapplicable at least in view of the fact that there is not a

prior art apparatus teaching all structural limitations of a claim (see MPEP 2114).

In view of at least the foregoing, Applicants respectfully submit that independent claims 1, 5, 16, 20, 23, and 26, as well as those claims that depend therefrom, are in condition for allowance.

Turning to independent claims 4 and 19, Applicants observe that Anderson and Ginter, taken individually or in combination, fail to disclose, teach, or suggest at least:

“... having [a] first party send to the first party’s clearing bank a first digital rights management container attached to an electronic mail message, said first container granting said first clearing bank permission to submit to a second party predetermined authentication data corresponding to said first party ...”
(see claims 4 and 19).

The Examiner argues that:

“[b]oth Anderson ‘739 and Ginter ‘140 describe transactions utilizing authentication protocols which requires requesting and receiving permission to submit predetermined authentication data, i.e. keys, digital signatures, etc., the art of encryption and authentication is well known and described in both of the references”
(emphasis added).

The Examiner appears to be arguing that the above-referenced aspect of claims 4 and 19 is known in the art to be an authentication operation.

Applicants respectfully disagree with the Examiner’s contention, and note that no support is provided for the contention.

For example, Anderson and Ginter, characterized by the Examiner as describing authentication as known in the art, fail to explain the above-referenced aspect of claims 4 and 19 to be an authentication operation. Nor does the Examiner offer any references that do explain the above-referenced aspect of claims 4 and 19 to be an authentication operation. Moreover, in view

of the Examiner's response to Applicants' last submission, the Examiner is apparently not taking Official Notice to support his position.

As the Examiner is aware, in order to establish a prima facie case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (see MPEP 2142).

Applicants respectfully submit that this criterion has not been met.

Applicants recognize the Examiner's citation of *Ex parte Masham*, 2 USPQ2d 1647, but believe this case law to be inapplicable at least in view of the fact that there is not a prior art apparatus teaching all structural limitations of a claim (see MPEP 2114).

In view of at least the foregoing Applicants respectfully submit that claims 4 and 19, and those claims that depend therefrom, are in condition for allowance.

With regard to independent claims 8 and 10, the Examiner makes reference to Anderson and Ginter, apparently recognizes that Anderson and Ginter, taken individually or in combination, do not disclose, teach, or suggest all claim aspects, but argues that "it would have been an obvious matter of design choice to modify the teachings of Anderson '739 and Ginter '140" to yield the claimed invention.

Similarly, with regard to independent claims 15 and 29 the Examiner cites various portions of the Anderson and Ginter references, apparently recognizes that the references, taken individually or in combination, do not disclose, teach, or suggest all claim aspects, but argues that the claimed invention "would have been obvious to one having ordinary skill in the art at the time the invention was made" in view of Anderson and Ginter.

However, in order to establish a prima facie case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (see

MPEP 2142).

As the Examiner appears to be aware, his discussion of the Anderson and Ginter references fails to identify disclosure, teaching, or suggestion of all aspects of claims 8, 10, 15, and 29. Applicants have reviewed the references and have found no such disclosure, teaching, or suggestion. Moreover, in view the Examiner's response to Applicants' last submission, the Examiner is apparently not taking any Official Notice.

Applicants submit that with respect to at least:

“... a first entity transmitting to the first entity's clearing bank a cash request electronic mail message, said message requesting that an electronic representation of cash be sent to a specified second entity ...”
(emphasis added)

as stated by claim 8,

“...a first entity submitting a voice request demanding that an electronic representation of cash be sent to a specified second entity ...”
(emphasis added)

as stated by claim 10, and

“... having a first party and a second party exchange negotiation digital rights management containers attached to electronic mail messages in order to negotiate the information each party is willing to have used for authentication purposes ... [and] ... having said first party send to the first party's clearing bank a first permission digital rights management container attached to an electronic mail message, said first permission container granting said first clearing bank permission to submit to said second party the information said first party agreed to supply in the negotiation ...”
(emphasis added).

as stated by claims 15 and 29, the above-discussed criterion for making a prima facie case of obviousness has not been met.

Applicants recognize the Examiner's citation of *Ex parte Masham*, 2 USPQ2d 1647, but believe this case law to be inapplicable at least in view of the fact that there is not a prior art apparatus teaching all structural limitations of a claim (see MPEP 2114).

In view of at least the foregoing, Applicants respectfully submit that claims 8, 10, 15, and 29, and those claims that depend therefrom, are in condition for allowance.

(Continued on next page)

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance for which action is earnestly solicited.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 3892-4002. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Furthermore, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account and Order No.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: May 3, 2004

By:



Angus R. Gill
Registration No. 51,133

Mailing Address:
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 415-8746
(212) 751-6849 (Fax)